

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:) U.S. Patent No. 7,621,412
Subodh K. Raniwala)
Application No. 10/606,439) Issue Date: November 24, 2009
Confirmation No. 2930) Examiner Niki Marina Eloshway
Filed June 26, 2003) Art Unit 3781
For: Hot Fill Container and Closure and Associated)
Method)

PETITION FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT
UNDER 37 C.F.R. § 1.705

Mail Stop Patent Ext.
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicant respectfully applies and/or petitions for reconsideration under 35 U.S.C. § 154 and 37 C.F.R. § 1.705(d) of the patent term adjustment indicated on the face of the above-identified U.S. Patent No. 7,621,412 ("the Patent") issued from the above-identified application.

Applicant notes that the present request has been filed within the two-month time limit from the issue date of the Patent set forth in 37 C.F.R. § 1.705(d), because January 24, 2010, falls on a Sunday. Additionally, Applicant notes that, under 37 C.F.R. § 1.705(d), no issues have been raised in this request that were raised, or could have been raised, in an application for patent term adjustment under § 1.705(b), because the error in patent term adjustment is based on the issue date of the Patent, which was not known before payment of the issue fee, and because the recent decision in *Wyeth and Elan*

Pharma v. Kappos (Fed. Cir., January 7, 2010) changed U.S.P.T.O. policy regarding calculation of patent term adjustments.

The Patent indicates a term adjustment of 247 days. However, Applicant respectfully submits that such a determination is not correct under 37 C.F.R. §§ 1.702-1.705 and that the proper term adjustment in this case should include both the sum of the periods under both §§ 1.703(a) and 1.703(b), according to *Wyeth v. Kappos*.

Statement of Pertinent Facts

1. The application was filed on June 26, 2003.
2. Fourteen (14) months after filing the application was August 26, 2004.
3. The first office action was mailed October 7, 2005.
4. The date three years after filing was June 26, 2006.
5. The Patent issued on November 24, 2009.
6. The first request for continued examination (RCE) in the application was filed on October 23, 2006.
7. The above-captioned application is not subject to a terminal disclaimer.
8. The total period of delay by Applicant totals no more than 208 days.
9. There was no overlap in the time periods:
 - a. Between August 26, 2004, and October 7, 2005 (i.e., 14 months from the filing date and the mailing date of the first office action), and
 - b. Between June 26, 2006 (i.e., three years from the filing date of the application), and the issue date of the Patent.

Remarks

The 247 days Patent Term Adjustment (PTA) indicated on the face of the Patent appears to take into account to the number of days that the mailing of the first office action was delayed beyond 14 months from the filing date, as well as the extension periods used by Applicant. However, the PTA ignores 37 C.F.R. § 1.703(b), i.e., the number of days beyond three years from the filing date that the application will issue into a patent, which was 1247 days beyond three years after filing the application. Under the recent decision in *Wyeth and Elan Pharma v. Kappos* (Fed. Cir., January 7, 2010), both the delay under § 1.703(a) and 1.703(b) must be factored into the patent term adjustment, unless those periods directly overlap with each other. In this case, there was no such overlap, as indicated in point (9) above. It is understood that the adjustment under § 1.703(b) may be reduced based on the filing of the RCE on October 23, 2006, which was 119 days beyond three years after filing the application.

Thus, the Patentee hereby requests reconsideration of the PTA listed on the face of the Patent and revision of the PTA by at least an additional 119 days, to a total of at least 366 days. The Office is authorized to charge any requisite fee for this paper to our Deposit Account No. 19-0733.

Respectfully submitted,

BANNER & WITCOFF, LTD.

Date: January 25, 2010

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